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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/541,193 04/03/00 HU

B CFP-1080

EXAMINER

QM22/1030

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SHAKERI, H

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

10/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/541,193

Applicant(s)

HU, BOBBY

Examiner

Hadi Shakeri

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings filed on 04/03/00 have been approved by the Draftsperson.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of copending Application No. 09/541,190 in view of Gordon Tools Ltd., GB 1 559 093. Copending application No. 09/541,190 discloses all the limitations of the instant application with the exception of the items (50) and (60). Gordon teaches the elements

to modify the copending application by an alternative means of urging the pawl to obtain the present claimed invention.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Shiao, US Patent No. 5,964,129.

Shiao discloses a ratchet wrench with all the limitations of claim 40, i.e., a head (102), a handle (19), a web, Fig. 2, a cavity (16) communicating with the hole, a compartment (15) in the web communicating with the cavity and an end communicating with the outside, leaving a bridge between the hole and the compartment.

6. Claims 1, 13, 14, 27 and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hare, US Patent No. 2,957,377.

With regards to claim 1, Hare discloses all the limitations of the above claims, i.e., a reversible ratchet wrench with a handle (11), a head (12), a hole (13), a web, Fig. 2, a cavity (16) defined in the web and communicating with the hole, a compartment (24) communicating with the first cavity. The wrench further includes a drive member (14) with a plurality of teeth (20), a pawl (19), a switch member with a turn-piece (35)

and an actuating plate (23) rotatably received in the compartment, biasing means (26) mounted between the actuating member and the pawl for positioning the switch member in one of the two ratcheting positions (31) and (30).

Regarding claims 13, PA as applied to claim 1 above meets all the limitations, i.e., drive column (50), Fig. 4.

Regarding claim 14, PA as applied to claim 1 above meets all the limitations, i.e., head being provided with an end wall (44) with an opening and drive member with a stub (49), Fig. 4.

Regarding claim 27, PA as applied to claim 1 above meets all the limitations, i.e., pawl with a recess on the side facing the compartment, Fig. 4.

Regarding claims 37 and 38, PA as applied to claim 27 above meets all the limitations, drive column (50), end wall (44) with an opening and drive member with a stub (49).

Regarding claim 39, PA as applied to claim 27 above meets all the limitations, i.e., compartment (24) communicating with the outside and the first cavity, creating a bridge, Figures 2-4.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 4, 15, 20, 21, 23, 24, and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Hare, US Patent No. 2,957,377 in view of Gordon Tools Ltd. GB Patent No. 1 559 093.

With regards to claims 3, 4, 15, 20, 21, 23, 24, and 26, Hare discloses all the limitations of the above claims, i.e., a reversible ratchet wrench with a handle (11), a head (12), a hole (13), a web, Fig. 2, a first cavity (16) defined in the web and communicating with the hole, a compartment (24) communicating with the first cavity and a second cavity (34) in communication with the compartment. The wrench further includes a drive member (14) with a plurality of teeth (20), a pawl (19), a switch member (23) (35) rotatably received in the compartment, means (26) mounted between the switch member and the pawl and means (33) (32) for positioning the switch member in one of the two ratcheting positions (31) and (32), turn-piece (35) and actuating plate (23); pawl with a recess (27), coil spring (26), drive column (50), end wall (44) with an opening and drive member with a stub (49), compartment (24) communicating with the outside and the first cavity, creating a bridge, Figures 2-4. It does not disclose a peg and an elastic element, which is attached to the actuating plate. Gordd-'093 teaches a pawl member (16) being urged by an elastic member in a receptacle of an actuating plate (10), Fig. 4, and a peg (20). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the urging means of the tool of Hare by providing a peg as taught by Gordon Tool Ltd. for durability.

Regarding the elastic element being attached to the actuating pale, it would have been obvious to one having ordinary skill in the art at the time the invention was made

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to attach the elastic member to the actuating plate, to retain it from falling out of the receptacle, as an obvious design choice which involves only routine skill in the art, since applicant has not disclosed that using a pin solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic member not attached to the actuating plate.

9. Claims 2, 12, 28 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare'377 in view of Shiao, US Patent No. 5,964,129.

Hare, as applied in this office action, discloses all the limitations of the above claims except for a drive member with inner periphery adapted to drive a fastener and a groove on the outer periphery, and wherein the inner periphery of the head includes an annular groove, a C-clip for rotatably retaining the drive in the head. Shiao teaches a ratchet wrench with a drive member (20) which has inner periphery (21) adapted to drive a fastener, with a groove on the outer periphery Fig. 2, for being retained with a groove (14) on the inside of the head by a C-clip (141). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Hare with the drive member, grooves and C-clip as taught by Shiao for driving fasteners.

10. Claims 5-11, 16-19, 22, 25, and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare, US Patent No. 2,957,377 in view of Gordon Tools Ltd. GB Patent No. 1 559 093 further in view of Shiao, US Patent No. 5,964,129.

Hare, as applied in this office action, discloses all the limitations of the above claims except for a peg and an elastic element, which is attached to the actuating plate and a drive member with inner periphery adapted to drive a fastener and a groove on the outer periphery, and wherein the inner periphery of the head includes an annular groove, a C-clip for rotatably retaining the drive in the head. Gordd-'093 teaches a pawl member (16) being urged by an elastic member in a receptacle of an actuating plate (10), Fig. 4, and a peg (20). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the urging means of the tool of Hare by providing a peg as taught by Gordon Tool Ltd. for durability.

Regarding the elastic element being attached to the actuating plate, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the elastic member to the actuating plate, to retain it from falling out of the receptacle, as an obvious design choice which involves only routine skill in the art, since applicant has not disclosed that using a pin solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic member not attached to the actuating plate.

Shiao teaches a ratchet wrench with a drive member (20) which has inner periphery (21) adapted to drive a fastener, with a groove on the outer periphery Fig. 2, for being retained with a groove (14) on the inside of the head by a C-clip (141). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the tool of PA with the drive member, grooves and C-clip as taught by Shiao for driving fasteners.

***Conclusion***

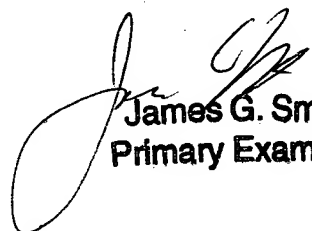
11. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Turner, Tuttle, Reams and Boosiner are cited to show related tools.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri at (703) 308-6279. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 5:00 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

HS

October 25, 2000

  
James G. Smith  
Primary Examiner